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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. McGARVEY[1]

Appeal 2007-3320
Application 09/759,475
Technology Center 2600

Decided: January 29, 2008

Before JAMESON LEE, RICHARD TORCZON, and SALLY C. MEDLEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Statement of the Case

This is a decision on appeal by an Applicant under 35 U.S.C. § 134(a) from a final rejection of claims 1-4, 6, 9, 12-21, 27-30, and 32. We have jurisdiction under 35 U.S.C. § 6(b).

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[1] The real party in interest is Eastman Kodak Company.

References Relied on by the Examiner

D'Luna	US 5,008,739	Apr. 16, 1991
Suzuki	US 5,691,772	Nov. 25, 1997
Thadani	US 6,201,530	Mar. 13, 2001

Thorpe and Takeuchi *The All-Digital Camcorder – The Arrival of Electronic Cinematography,* SMPTE Journal, Vol. 105, No. 1, 13-30 (1996) (hereinafter "Thorpe")

The Rejections on Appeal

The Examiner rejected claims 1, 3, 4, 6, 9, 12, 15-20, 27-30, and 32 under 35 U.S.C. § 103(a) as unpatentable over Thorpe and Suzuki.

The Examiner rejected claims 2 and 14 under 5 U.S.C. § 103(a) as unpatentable over Thorpe, Suzuki, and D'Luna.

The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as unpatentable over Thorpe, Suzuki, and Thadani.

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over Thorpe and D'Luna.

B. Issues

Has the Applicant shown error in the rejection of claims 1-4, 6, 9, 12-21, 27-30, and 32 under 35 U.S.C. § 103 as unpatentable over prior art?

C. Summary of the Decision

The Applicant has not shown error in the rejection of any claim under 35 U.S.C. § 103 as unpatentable over prior art.

D Findings of Fact (Referenced as FF. ¶ No.)

1. The Applicant's invention is directed to a digital camera system which stores in the camera white balance settings for different venues, with a

respective associated file identifier for each venue. (Spec. Summary of the Invention).

2. According to the Applicant, prior art systems only allow one setting to be stored, and the saved setting is erased and cannot be recalled once a new setting is stored. (Spec. 1:30 to 2:1).

3. Further according to the Applicant, photographers typically do not want to determine the proper white balance setting for a venue each time they want to take a picture at the venue. (Spec. 5:19-20).

4. That perceived problem, however, was already solved by the system disclosed in Thorpe.

5. Thorpe discloses a camera system which includes multiple removable electronic setup memory cards each one of which stores the complete control settings for a particular "image look." (Thorpe 22:1:17 to 23:3:5).

6. Thorpe states (Thorpe 24:1:7 to 24:3:10):

> Rental houses and production facilities can prepare set-up cards for a wide variety of such customized image-making choices. Over a period of time involving various shooting experiences, the particular look sought by a film cinematographer or videographer can be readily supplied in the form of an appropriately identified set-up card.
>
> A major step in eliminating "video-tweaking" during location shooting is provided by this unique electronic card system, bringing the video camcorder a large step closer to the adjustment-free operation of a film camera. Digital EC is thus rendered more friendly to the skilled film cinematographer.

7. Independent claim 1 reads as follows:

Claim 1. A white balance picture correction process implemented in a digital camera having a processor, a memory and a user interface, comprising the steps of:

determining a white balance digital camera processing setting for a picture taking venue at a visit to the venue;

saving the setting for the venue; and

correcting pictures taken at a subsequent visit to the venue with the saved setting;

the determining step further comprising capturing an image utilizing the digital camera and processing the captured image in the processor of the digital camera to determine the white balance setting;

the saving step further comprising storing the white balance setting in the memory of the digital camera in a file having an identifier which allows a user of the digital camera to correlate the identifier with the venue;

the memory being configurable to store the determined white balance setting and at least one additional white balance setting for another picture taking venue, the determined white balance setting being selectable from the plurality of stored white balance settings, for use in the correcting step, via the user interface of the digital camera.

8. The Examiner determined that Thorpe discloses each and every feature of claim 1 except the very last limitation of (See Ans. 3:7 to 4:4):[2]

the memory being configurable to store the determined white balance setting and at least one additional white balance setting for another picture taking venue, the determined white balance setting being selectable from the plurality of stored white balance settings, for use in the correcting step, via the user interface of the digital camera.

[2] This finding of the Examiner is not challenged by the Applicant.

9. Suzuki discloses a camera system with white balance adjustment abilities, including (1) a memory table 108M which stores the gain for fine weather, cloudy, and tungsten light sources, which is produced when white balance adjustment is set in manual mode, and (2) a memory table 108K which stores the gains for various fluorescent lamps used when fluorescent lamp manual mode is selected. (Suzuki 4:54-65).

10. Suzuki discloses that the supporting memory circuitry can be a random access memory or a read-only memory. (Suzuki 4:24-29).

E. Principles of Law

Obviousness is a legal determination made on the basis of underlying factual inquiries including (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any objective evidence of unobviousness, *Graham v. John Deere Co.,* 383 U.S. 1, 17 (1966). One with ordinary skill in the art is presumed to have skills apart from what the prior art references explicitly say. *See In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985). A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton. *KSR International Co. v. Teleflex Inc.,* 127 S.Ct. 1727, 1742 (2007).

In *KSR International Co.*, 127 S.Ct. at 1742-43, with regard to motivation to combine teachings, the Supreme Court stated: "Rigid preventive rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it." In an obviousness analysis, it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and

creative steps that a person of ordinary skill in the art would employ can be taken into account. *See KSR International Co.,* 127 S.Ct. at 1741.

Also, motivation to combine teachings need not be expressly stated in any prior art reference. *In re Kahn*, 441 F.3d 977, 989 (Fed. Cir. 2006). There need only be an articulated reasoning with rational underpinnings to support a motivation to combine teachings. *In re Kahn*, 441 F.3d at 988.

The test for determining obviousness is not whether the features of one reference may be bodily incorporated into the system disclosed in another reference, but whether the collective teachings as viewed by one with ordinary skill in the art would have rendered the claimed subject matter obvious. *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). A prior art reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir.), *cert. denied*, 474 U.S. 843 (1985). A reference must be evaluated for all its teachings and is not limited to its specific embodiments. *In re Bode*, 550 F.2d 656, 661 (CCPA 1977).

During examination, claim terms are given their broadest reasonable interpretation consistent with the specification. *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). It is improper to read limitations from examples given in the specification into the claims. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988). The name of the game is the claim. *In re Hiniker Co.*, 150 F.3d 1367, 1369 (Fed. Cir. 1998).

F. Analysis

As in any appeal, the Applicant as appellant bears the burden of demonstrating error in the rejections on appeal.

The independent claims are claims 1, 15, 21, 27, 28, 29, and 32. The Applicant has not argued the merits of any dependent claim separate from that of the independent claim from which it depends. The Applicant also has not argued the merits of any independent claim separately from that of other independent claims, except for claims 1 and 21. We discuss only claims 1 and 21. Note that simply stating the features of a claim does not constitute an argument for separate patentability of that claim. Board Rule 37(c)(vii).

We focus our analysis on the contested limitations. *Aero Prods. Int'l, Inc. v. Intex Rec. Corp.*, 466 F.3d 1000, 1012 n.6 (Fed. Cir. 2006). First, the Applicant argues that because Thorpe's system requires use of a plug-in setup card for each separate venue for picture taking, it not only fails to teach the claim limitation of storing the respective settings of multiple venues in the memory of the digital camera but teaches away from that feature (Br. 9:25 to 10:2). The argument is rejected.

Simply disclosing something different is not a "teaching away" in the sense of affirmatively advising not to take a certain approach or disclosing that a particular scheme is unworkable. At most, Thorpe just discloses a different scheme. In any event, we do not see why the three memory cards of Thorpe as shown in Figure 16b cannot all be deemed a part of the memory of the camera system if the user selects all of them for use with the camera. Claim 1 nowhere requires the memory of the camera to be on a single chip or a single memory card. During examination, claim terms are given their broadest reasonable interpretation consistent with the

specification. *In re Icon Health & Fitness, Inc.*, 496 F.3d at 1379. Nothing in Applicant's specification defines camera memory as necessarily implemented as only a single chip or card. Indeed, Applicant's specification even regards the combination of internal memory 36 and removable memory card 32 collectively as the camera memory. In that regard, the specification states (Spec. 5:23-27):

> The white balance setting for each venue is determined and stored in a file named by the user. The file can be created/located in the camera white balance memory 36 and/or in the removable memory card 32 and duplicated on a separate computer 38, such as a desktop computer, available to the user.

Even if the disclosed embodiment regards only a single memory card as the camera memory, it is improper to read limitations from the specification into the claims. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d at 1571. The name of the game is the claim. *In re Hiniker Co.*, 150 F.3d at 1369.

Accordingly, Applicant's argument does not distinguish the invention of claim 1 from the disclosed camera system of Thorpe. Thus, the Applicant has not shown error in the rejection of claims 1-4, 6, 9, 12-20, 27-30, and 32.

We further discuss the issue, in the alternative, now assuming arguendo that a camera memory cannot comprise more than a single memory card. The Applicant correctly points out that Suzuki does not disclose the storing of multiple white balance settings, one for each venue, in a camera memory, but the storing of multiple generic and non-venue-specific factors useful for providing white balance correction at the time of taking a photograph. The Applicant also correctly points out that Suzuki does not appear to pre-store a white balance setting for any particular venue, but rather teaches that the white balance setting used to provide white

balance correction is recomputed upon each visit to the venue based in part on the stored generic factors selected by the photographer. But those arguments are misplaced because the Examiner did not find Suzuki as disclosing that the setting for multiple venues are concurrently stored in the camera's memory.

The Applicant is under a mistaken impression that every single feature of a claimed invention must be found in one of the cited prior art references in an obviousness rejection. There is no such requirement. While it is true that in an anticipation rejection under 35 U.S.C. § 102 every claimed feature must be found within the four corners of a single prior art reference, for an obviousness rejection there is no corresponding rule that every claim feature must be found specifically within a reference. That should not be surprising because the issue is obviousness. That there are differences between the claimed invention and the prior art is already presumed. The inquiry under 35 U.S.C. § 103 is whether the differences are such that the claimed invention as a whole would have been obvious to one with ordinary skill.

The level of ordinary skill in the art is reflected in the prior art references cited of record. In particular, Suzuki discloses that one with ordinary skill in the art would have known that the memory in a digital camera can be used to store a variety of setting control information useful for computing the proper setting at the time of taking of a photograph. For instance, Suzuki states (Suzuki 4:54-65):

> A control table 108A for use in auto white balance is a memory which in auto mode, along with processing the values Rb/Gb and Bb/Gb as parameters, stores the gain of the variable amplifier circuits 104R and 104B. A control table 108M for use in manual white balance is a memory which stores the gain for fine weather, cloudy, and tungsten light sources which is

> produced when white balance adjustment device is set in a manual mode. A control table 108K for use in fluorescent lamp white balance situations is a memory to store the gains for the kind of fluorescent lamp used in situations wherein fluorescent lamp manual mode is selected.

One with ordinary skill is presumed to be skilled, *In re Sovish*, 769 F.2d at 743, has ordinary creativity and is not an automaton. *KSR International Co.,* 127 S.Ct. at 1742. The Examiner reasoned (Ans. at 4) that in light of Suzuki's disclosure of storing a variety of white balance setting variable values in one memory, one with ordinary skill would have known or been led to storing the white balance setting of more than one venue on one memory. The idea conveyed by Suzuki is that a camera memory is useful for storing a variety of setting data. If the camera memory is useful for storing values corresponding to different selectable factors for computing the white balance at various venues when needed, why wouldn't it be useful for storing the setting of multiple venues if it is already known to predetermine the white balance setting for each venue? From the perspective of one with ordinary skill in the art, the answer is that of course it would. That is the rationale articulated by the Examiner. It is logical and reasonable. Motivation to combine teachings need not be expressly stated in any prior art reference. *In re Kahn*, 441 F.3d at 989. There need only be an articulated reasoning with rational underpinnings. *In re Kahn*, 441 F.3d at 988. Here, there is. Storing the contents of plural camera memory cards all in one camera memory yields nothing more than a predictable result, eliminating the need to carry multiple memory cards.

Accordingly, on the above-stated alternative basis, the Applicant has not shown error in the rejection of claims 1-4, 6, 9, 12-20, 27-30, and 32.

As for claim 21, the Applicant relies on the same argument as that presented in connection with claim 1 and an additional argument, i.e., "that the set-up card system of Thorpe does not involve such assignment of file name identifiers via a user interface of a digital camera" (Br. 17:18-19). The argument completely ignores this statement of the Examiner in the final Office action specifically with regard to claim 21 (Final Rej. 20:1-2):

> Official Notice is taken that a camera comprises a user interface for assigning file name identifiers to the settings.

In the Answer, the Examiner again reiterated the official notice relied upon for the rejection of claim 21 (Ans. 20:1-2). The Applicant filed no reply. Applicant's failure to challenge the above-noted official notice taken by the Examiner renders unpersuasive the argument that the feature is not disclosed by Thorpe or met by the combination of Thorpe and D'Luna.

The Applicant has not shown error in the rejection of claim 21.

G. Conclusion

The rejection of claims 1, 3, 4, 6, 9, 12, 15-20, 27-30, and 32 under 35 U.S.C. § 103(a) as unpatentable over Thorpe and Suzuki is **affirmed**.

The rejection of claims 2 and 14 under 35 U.S.C. § 103(a) as unpatentable over Thorpe, Suzuki, and D'Luna is **affirmed.**

The rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over Thorpe, Suzuki, and Thadani is **affirmed**.

The rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over Thorpe and D'Luna is **affirmed**.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

MAT

cc: First Class Mail

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